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In re Application of
Michael N. Grimbergen
Serial No.: 09/379,753
Filed: August 24, 1999
For: MONITORING A PROCESS AND COMPENSATING FOR
RADIATION SOURCE FLUCTUATIONS

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: DECISION ON
: PETITION
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This is a decision on the PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT, filed August 13, 2001, requesting that the abandonment, as set forth in the Notice of Abandonment of June 10, 2001, for failure to timely respond to the Office action of October 20, 2000 be withdrawn. The petitioner asserts that the applicants' response of April 17, 2001, which included an amendment, a request for a three month extension of time, and a fee payment, was a proper reply to the final Office action of October 20, 2000.

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181(no fee) - no abandonment-in-fact. A review of the entire application history indicates that the petitioner's request cannot be granted. Specifically, 37 C.F.R. 1.116 states:

"37 CFR 1.116.

(a) After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. **The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.**" (Emphasis added).

While, 37 CFR 1.113 states:

"37 CFR 1.113

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, **whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191) or to amendment as specified in § 1.116.** Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objection as to form." (Emphasis added).

In the instant application, the six month statutory period for response to the final Office action of October 20, 2000 expired on April 20, 2001. The applicants' response of April 17, 2001 included an AMENDMENT and a PETITION FOR EXTENSION OF TIME, but did not include a Notice of Appeal. The examiner's Advisory Action of April 30, 2001 clearly indicated that the April 17, 2001 proposed amendment, raised new issues and did not place the rejected claims into allowable form. Since the applicants' response of April 17, 2001 did not place the application in condition for allowance, and did not include a Notice of Appeal under 37 C.F.R. 1.191, the application was properly abandoned.

The request for withdrawal of the holding of abandonment is **DENIED.**



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